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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/879,160	06/13/2001	Shigehisa Tonomura	1341.1095	3652

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EXAMINER

KE, PENG

ART UNIT PAPER NUMBER

2174

DATE MAILED: 05/05/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/879,160

Applicant(s)

TONOMURA, SHIGEHISA

Examiner

Peng Ke

Art Unit

2174

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 27 December 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date: _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

This action is responsive to communications: Amendment, filed on 12/27/04.

This action is final.

Claims 1-19 are pending in this application. Claims 1, 6-12, and 19 are independent claims. In the Amendment, filed on 5/12/2004, claims 2, 14, 16, and 18 were amended.

### **Claim Rejections - 35 USC § 102**

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1, 3 - 13, 15, 17 and 19 are rejected under 35 U.S.C. 102(e) as being anticipated by Yokota, U.S. Patent No. 6,604,049.

As per claim 1, Yokota teaches an information providing method comprising the steps of: accepting photographed data including photographing position information from a user (see Yokota, column 3, lines 31 - 35); acquiring a content corresponding to the photographing

position information from a position-distinction contents database based on the photographing position information in the accepted photographed data, wherein said position-distinction contents database stores photographing position information and the content in a correlated manner (see Yokota, column 3, lines 40 - 45 and column 9, lines 16 - 28); and inserting and editing the acquired content into a portion of the photographed data corresponding to the photographing position information (see Yokota, column 10, lines 8 - 14), wherein the content includes data symbolizing an area which corresponds to the photographing position information and in which the photographed data is originally obtained (see Yokota, column 4, lines 2 - 6).

As per claim 3, which is dependent on claim 1, Yokota teaches the method of claim 1 (see rejection above). Yokota further teaches the information providing method according to claim 1, wherein the accepting step further includes the steps of, accepting information for specifying the user along with the photographed data including the photographing position information (see Yokota, column 9 lines 45 - 52); and transmitting the inserted and edited photographed data to the user based on the accepted information for specifying the user (see Yokota, column 6, lines 18 - 22).

As per claim 4, which is dependent on claim 1, Yokota teaches the method of claim 1 (see rejection above). Yokota further teaches the information providing method according to claim 1, wherein the photographed data are data photographed in a certain bigger area, and the photographing position information is information about a smaller area in the bigger area where

Art Unit: 2174

the photographing is executed or information showing a photographing spot (see Yokota, figure 8 and column 11, lines 46 = 63).

As per claim 5, which is dependent on claim 1, Yokota teaches the method of claim 1 (see rejection above). Yokota further teaches the information providing method according to claim 1, wherein the photographed data are frames of original dynamic images (see Yokota, column 7, lines 52 - 55; the examiner interprets images captured by a digital camera as frames of original dynamic images).

As per claim 6, Yokota teaches an Information receiving method comprising the steps of: transmitting photographed data including photographing position information to a server; and receiving the photographed data, into which contents corresponding to the photographing position information are inserted and edited by the server, from the server based on the transmitted photographing position information (see Yokota, column 3, lines 31 - 45).

As per claims 7, 9, 11 and 12, they are of similar scope to claim 1 and are rejected under the same rationale as claim 1 (see rejection above),

As per claims 8 and 10, they are of similar scope to claim 6 and are rejected under the same rationale as claim 6 (see rejection above).

As per claim 13, which is dependent on claim 1, Yokota teaches the method of claim 1 (see rejection above). Yokota further teaches the information providing method according to claim 1, further comprising: transmitting the inserted and edited photographed data to the user based on information specifying the user, to increase a value of the photographed data as a commemorative photograph (see Yokota, column 6, lines 18 - 22; the examiner interprets sending additional data regarding a location of interest to the user as increasing the value of the photographed data as a commemorative photograph because it allows a user to gain more information regarding the photographed data),

wherein the photographed data accepted from the user includes the information specifying the user (see Yokota, column 9 lines 45 - 52).

As per claims 15 and 17, they are of similar scope to claim 13 and are rejected under the same rationale as claim 13 (see rejection above).

As per claim 19, Yokota teaches an image processing system, comprising: a database including photographic position information and an image content correlated with the photographic position information, the image content including image data of an area corresponding to the photographic position information (see Yokota, column 3, lines 40 - 45 and column 9, lines 16 - 28); a user client device which transmits photograph data including photographic position information of where the photograph data was obtained (see Yokota, column 3, lines 31 - 35); a computer which acquires the image content correlated with the photographic position information from the database when the user client transmits the

photograph data, and which inserts the acquired image content into the photograph data (see Yokota, column 10, lines 8 - 14).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 2, 14, 16, and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yokota, U.S. Patent No. 6,604,049 in view of Yoon et al., U.S. Patent No. 6,173,407.

As per claim 2, which is dependent on claim 1, Yokota teaches the method of claim 1 (see rejection above). Yokota does not teach the information providing method according to claim 1 further comprising the step of calculating an appropriate fee based on the content provided. Yoon et al. ("Yoon") teaches an information providing method comprising the step of calculating an appropriate fee for providing content (see Yoon, column 7, lines 9 - 50). It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate

the method of Yoon with the method of Yokota in order to generate revenue for the content provider.

As per claims 14, 16 and 18, they are of similar scope to claim 2 and are rejected under the same rationale as claim 2; see rejection above).

### *Response to Argument*

Applicant's arguments filed on 12/27/05 have been fully considered but they are not persuasive.

Applicant argues that Yokota fails to teach, "photographing position information."

Examiner disagrees. During patent examination, the pending claims must be "given \*>their< broadest reasonable interpretation consistent with the specification." > In re Hyatt, 211 F.3d 1367, 1372, 54 USPQ2d 1664, 1667 (Fed. Cir. 2000). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See In re Van Geuns, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Applicant always has the opportunity to amend the claims during prosecution, and broad interpretation by the examiner reduces the possibility that the claim, once issued, will be interpreted more broadly than is justified. In re Prater, 415 F.2d 1393, 1404-05, 162 USPQ 541, 550-51 (CCPA 1969) In this case, the claims recites "photographing position information", and Yokota teaches obtaining geographical location information regarding where the photograph is taken. Yokota's teaching



reads onto the limitation recited by the claims because geographical location can be considered as "photographing position information."

#### Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Peng Ke whose telephone number is (571) 272-4062. The examiner can normally be reached on M-Th and Alternate Fridays 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kristine L. Kincaid can be reached on (571) 272-4063. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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